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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,412	04/22/2005	Akifumi Okuda	0425-1185PUS1	9129
2292 7590 08/08/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER SHAHNAN SHAH, KHATOOL S				
ART UNIT 1645		PAPER NUMBER		
NOTIFICATION DATE 08/08/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

# Office Action Summary

**Application No.**

10/532,412

**Applicant(s)**

OKUDA ET AL.

**Examiner**

Khatol S. Shahnan-Shah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 2, 4, 6 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3 and 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CIS-100)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 2/11/2008

***DETAILED ACTION***

1. Applicants' amendments of May 12, 2008 are acknowledged. Claims 1, 5 and 6 have been amended. Specification and abstract have been amended.

***Status of Claims***

2. Claims 1-7 are pending in this application. Claims 2, 4, 6, 7 have been withdrawn from consideration as being drawn to non-elected inventions. Claims 1, 3, 5 are under consideration.

***Objections Withdrawn***

3. Objection to the specification in regard to sequence compliance made in paragraph 3 of the office action mailed February 6, 2008 is withdrawn in view of applicants' amendments of May 12, 2008.

4. Objection to the abstract made in paragraph 6 of the office action mailed February 6, 2008 is withdrawn in view of applicants' amendments of May 12, 2008.

5. Objection to the specification in regard to trademark compliance made in paragraph 4 of the office action mailed February 6, 2008 is withdrawn in view of applicants' arguments of May 12, 2008.

***Objections Maintained***

6. Objection to the specification in regard to an embedded hyperlink and/or other form of browser-executable code, made in paragraph 4 of the office action mailed February 6, 2008 is maintained. The applicants have edited the hyperlink to a website. The attempt to incorporate subject matter into the patent application by reference to a hyperlink and/or other forms of browser-executable code is considered to be an improper incorporation by reference. See 37 CFR 1.57(d) and MPEP § 608.01(p), paragraph I regarding incorporation by reference.

***Rejections Withdrawn***

7. Rejection of claim 5 under 35 U.S.C. 101 made in paragraph 12 of the office action mailed February 6, 2008 is withdrawn in view of applicants' amendments of May 12, 2008.

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8. Rejection of claims 1, 3 and 5 under 35 U.S.C. 112 first paragraph enablement (lack of biological deposit) made in paragraph 14 of the office action mailed February 6, 2008 is withdrawn in view of applicants' amendments of May 12, 2008.

9. Rejection of claims 1, 3 and 5 under 35 U.S.C. 112 second paragraph made in paragraph 16 of the office action mailed February 6, 2008 is withdrawn in view of applicants' arguments of May 12, 2008.

10. Rejection of claims 1, 3 and 5 under 35 U.S.C. 102 (e) made in paragraph 18 of the office action mailed February 6, 2008 is withdrawn in view of applicants' arguments of May 12, 2008.

### ***Rejections Maintained***

#### ***Double Patenting***

11. Rejection of claims 1, 3 and 5 based on a judicially created obvious type double patenting made in paragraph 10 of the office action mailed February 6, 2008 is maintained.

The rejection was stated below:

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

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double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3 and 5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 24 of copending Application No.11/213,962. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims of both applications are drawn to production of a macrolide compound or its derivative by a biological transformation method using *Streptomyces* species. The formula II and I of claim 1 of the instant application and the formula 2 and 3 of Application No.11/213,962 are variant of each other because claim 1 of Application No.11/213,962 recites that the R group on those formula is hydroxy, acetoxy or methoxy. Claim 24 of Application No.11/213,962 recites that culturing *Streptomyces* sp. Mer 11107, FERM p-18144 or its variants can be used to obtain the claimed compound or its derivative.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicants' arguments of May 12, 2008 have been fully considered but they are not persuasive.

The applicant argues:

- Applicants note that the invention disclosed in U.S. Patent Application Serial No. 11/213,962 requires a fermentation step to obtain pladeinolate B or pladienolate D. However, in contrast, the '962 application fails to disclose or suggest hydrooxidation (-OH) of the fermentation product at the 16-position. The presently claimed invention includes production of a macrolide compound 1107D of formula (It) having a hydroxyl (OH) group at the 16 position, by starting from a macrolide compound 11107B of formula (I) which has no hydroxyl (OH)

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group at the 16 position. The production is performed by incubation with a microorganism, as claimed.

In response to the applicants' argument, it is the office position that claims 1 and 24 of Application No.11/213,962 does not recite a fermentation step furthermore claim 1 of Application No.11/213,962 recites that the R group on those formula is hydroxy, acetoxy or methoxy. Claim 24 of Application No.11/213,962 recites that culturing *Streptomyces* sp. Mer 11107, FERM p-18144 or its variants can be used to obtain the claimed compound or its derivative.

### ***New Rejections***

#### ***Claim Rejections - 35 USC § 102***

**12.** The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Note: As mentioned in the previous action, acknowledgment is made of applicants' claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. Japan 2002-346796, filed on 11/29/2002. However, no translation of said application has been filed. For the purpose of prior art the priority date will be granted as the filing date of PCT application of **11/27/2003**.

**13.** Claims 1, 3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Asai et al. (WO 02/0600890A1). Prior art of record applicants' 1449.

Claims are drawn to a method of producing a macrolide compound 11107D from a macrolide compound 11107B by a biological transformation method comprising the steps of:

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- a) contacting compound 11107B with genus *Streptomyces*;
- b) incubating the mixture; and
- c) collecting compound 11107D from the mixture.

Asai et al. teach a method of producing a macrolide compound 11107D from a macrolide compound 11107B by a biological transformation method comprising the steps of:

- a) contacting compound 11107B with genus *Streptomyces*;
- b) incubating the mixture; and
- c) collecting compound 11107D from the mixture. (see column 37, column 38, lines 33-68, and column 39, lines 1-40).

Asai et al. teach 11107B ( see pages 5 and 67 and 72 ) 11107D ( see pages 5 and 67 and 75 ), conversion of 11107B to 11107D biological transformation or bioconversion ( see abstract ), *Streptomyces* Mer -11107 FERM P-1844 or its mutants) ( see preparation ). Since FERM BP-8551 strain characteristics is unknown, the strain has not been disclosed. Therefore it is determined that the strain of *Streptomyces* used by Asai et al. is identical to the strain recited in claim 5 since the required bioconversion is achieved by the strain of Asai et al. The prior art teaches the claimed invention.

***Claim Rejections - 35 USC § 103***

**14.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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15. Claims 1, 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable by Seki-Asano et al. (The Journal of Antibiotics, vol. 47, No. 12, pp. 1395-1401, 1994).

Claims are drawn to a method of producing a macrolide compound 11107D from a macrolide compound 11107B by a biological transformation method comprising the steps of:

- a) contacting compound 11107B with genus *Streptomyces*;
- b) incubating the mixture; and
- c) collecting compound 11107D from the mixture.

Seki-Asano et al. teach isolation and characterization of a new 12- membered macrolide FD-895 with a basic structure recited in figure 1 which is produced from by biological transformation from a culture of *Streptomyces hygroscopicus* A-9561. The instant claims read on the method and compound which is taught by the reference. The reference teach the basic structure of the claimed formulas I and II.

Since FERM BP-8551 strain characteristics is unknown, the strain has not been disclosed. Therefore it is determined that the strain of *Streptomyces* used by Seki-Asano et al. is identical to the strain recited in claim 5 since the required bioconversion is achieved by the strain of Seki-Asano et al.

It would be *prima facie* obvious to one of the ordinarily skilled in the art to replace the methyl group at the position 16 of the FD-895 to a hydroxyl group to obtain compound 11107D of formula II. Production and substitution of methyl or hydroxyl group in the same scaffold in a family of known antibiotic compounds will be considered as optimization of assay parameters.

### **Conclusion**

16. Claims 1, 3, 5 are rejected.

Claims 2, 4, 6, 7 are withdrawn from consideration as being drawn to non-elected inventions.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.



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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khatol Shahnan-Shah whose telephone number is (571)-272-0863. The examiner can normally be reached on Mondays and Wednesdays from 12:30-6:30 PM and Thursdays from 12:30-4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shanon Foley can be reached on 571-272-0898.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Khatol Shahnan-Shah  
Biotechnology Patent Examiner  
Art Unit 1645  
July 28, 2008

/Shanon A. Foley/  
Supervisory Patent Examiner, Art Unit 1645